



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,782	10/16/2003	Tomohito Ota	023971-0323	7012
<div>22428 7590 06/06/2007</div> <div>FOLEY AND LARDNER LLP</div> <div>SUITE 500</div> <div>3000 K STREET NW</div> <div>WASHINGTON, DC 20007</div>				
			EXAMINER	
			GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1714	
			MAIL DATE	DELIVERY MODE
			06/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,782	Applicant(s) OTA ET AL.	
	Examiner James Goloboy	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Please note the new examiner of record.
2. The finality of the previous office action is withdrawn and the amendment of 5/21/07 has been made of record.

Claim Rejections - 35 USC § 103

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seguchi in view of JP 63-179965 and Wicks (*Kirk-Othmer Encyclopedia of Chemical Technology, Coatings*, John Wiley & Sons, 2002, p. 90).

The discussions of Seguchi and JP 63-179965 in paragraph 5 of the office action mailed 1/19/07 and paragraph 13 of the office action mailed 4/24/06 are incorporated here by reference.

Seguchi and JP 63-179965 disclose the combination of a lubricating oil and a thermoplastic resin composition of claim 5, but do not disclose the surface energy (surface tension) of the lubricating oil. Wicks, in the first paragraph of section 6.1, teaches that for wetting to occur, the surface tension of the coating (lubricating oil) must be lower than the surface energy of the substrate (thermoplastic resin). In light of this teaching, it would have been obvious to one of ordinary skill in the art to select a lubricating oil with a surface energy meeting the limitations of claim 5, in order to obtain good wetting of the surface with the lubricant.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto in view of Seguchi.

This rejection is adequately set forth in the office action mailed 1/19/07.

Response to Arguments

5. Applicant's arguments filed 5/21/07 have been fully considered but they are not persuasive.

Applicant's arguments with regard to the rejection of claim 5 are moot in light of the new grounds of rejection, which incorporate a teaching that motivates the selection of a resin and a lubricant meeting the surface energy requirement of claim 5.

In response to applicant's arguments regarding the rejection of claim 6, Yamamoto teaches that a thermoplastic resin may be incorporated into the fluororesin. It is the examiner's position that in the absence of evidence to the contrary, the product obtained by the method of Yamamoto when the proportions of fluororesin and thermoplastic resin taught by Seguchi are used, is the same as the product produced by the method of claim 6.

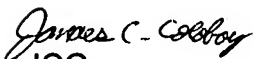
Conclusion

Art Unit: 1714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JCG

/Vasu Jagannathan/
Supervisory Patent Examiner
Technology Center 1700